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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/739,085	12/19/2003	Hiroshi Hagino	246754US	9926
22850 7590 05/05/2008 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER VAKILL, ZOIREH				
ART UNIT 1614		PAPER NUMBER		
NOTIFICATION DATE 05/05/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/739,085

Applicant(s)

HAGINO ET AL.

Examiner

ZOHREH VAKILI

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-15, 17, 18 and 20-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-15, 17, 18 and 20-27 is/are rejected.
- 7) ☒ Claim(s) 21-24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's Amendment filed January 10, 2008 has been received and entered into the present application. Claims 8-15, 17-18, 20-27 are pending and are herein examined on the merits.

Applicant's arguments, filed January 10, 2008 have been fully considered. Rejections not reiterated from previous Office Actions are hereby withdrawn. The following rejections are either reiterated or newly applied. They constitute the complete set of rejections presently being applied to the instant application.

Claim Objections (New Grounds of Rejection)

Claims 21-24 are objected to because of the following informalities: Claims 21-24 are objected to because they depend from a cancelled claim. Appropriate correction is required.

Claim Rejections - 35 USC § 112 (New Grounds of Rejection)

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8-15, 17-18, and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

"The primary purpose of this requirement of definiteness of claim language is to ensure that the scope of the claim is clear so the public is informed of the boundaries of what constitutes infringement of the patent. A secondary purpose is to provide a clear measure of what applicants regard as the invention so that it can be determined whether the claimed invention meets all the criteria for patentability and whether the specification meets the criteria of 35 U.S.C. 112, first paragraph with respect to the claimed invention." (MPEP 2173).

The term "a water-soluble hydrolysate thereof" renders the claims indefinite. The term is not defined by the claim or the specification, and thus one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Maintained Claim Rejections - 35 USC § 103

The rejection of claims 8-15, 17-18, 20-27 under 35 U.S.C. 103(a) as being unpatentable over Albitskaya et al. of RU 2044770, in view of Briand (US Patent No. 5508033), and further in view of Zulli et al. (US Pub. No. 2002/0160064 A1) has been maintained for the reasons stated in the prior Office Action, October 10, 2007.

Response to Argument

Applicant in his remarks argues that Albitskaya does not disclose or suggest a composition containing an algae extract from non-Chlorella algae and it would have not provided a reasonable expectation of success for extracting proteins from red, green, or brown algae due to significant structural and taxonomic differences between microalgae such as Chlorella and red, green, and brown algae. Further, Applicant discusses that Briand does not provide a reasonable expectation of success for the cosmetic properties of the algal protein and peptide extracts of the invention, such as their ability to enhance hair and skin shine and moistness. Applicant also discusses that Zulli does not disclose or suggest the extracts of the invention.

Examiner does not agree. Albitskaya is cited because it teaches algae that are subjected to hydrolysis via proteolytic enzymes in order to obtain the protein hydrolysate. Further, this claim is defined as a product-by-process claim and is a product, not a process, see *In re Bridgford*, 357 F2d 679, 149, USPQ 5 (CCPA 1966). It is the patentability of the product claimed and not of the recited process steps which must be established, see *In re Brown*, 459 F2d 531, 173 USPQ 685 (CCPA 1972); *In re Wertheim*, 541 F2d, 191 USPQ (CCPA 1976). A comparison of the recited process with the prior art processes does not serve to resolve the issue concerning the patentability of the product, see *In re Fessman*, 489 F2d 742, 180 USPQ 324 (CCPA 1974). Briand is cited because it uses algae extracts obtained by extraction in liquid phase, for the preparation of pharmaceutical, cosmetics, and food compositions. The

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algae used are brown, green, or red macroscopic algae. The shine or moistness produced by these algal extracts are the physical properties of these algae. The extraction in water followed by filtration and drying step is a process of making the algae extract and the process is an intended use in a composition claim and does not have a patentable weight. An intended use fails materially or physically limit the structure of the composition of the prior art can perform such a use, then it meets the claims. Zulli clearly is cited for the concentration of algae used in the composition. Further, Applicant is reminded that the obviousness rejection is not an anticipation rejection. Albitskaya along with Briand taken with Zulli clearly teaches the composition. In obviousness rejection a combination of references is used, and the references are relied upon in combination and are not meant to be considered separately as in a vacuum. It is the combination of all of the cited and relied upon references that make up the state of the art with regard to the claimed invention. Applicant's claimed invention fails to patentably distinguish over the state of the art represented by the combination of the cited references. *In re Young*, 403 F.2d 754, 159 USPQ 725(CCPA 1968); *In re Keller* 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Moreover, it is noted that rejections under 35 U.S.C. 103(a) are based on combinations of references, where the secondary references are cited to reconcile the deficiencies of the primary reference with the knowledge generally available to one ordinary skill in the art to show that the differences between Applicant's invention and the prior art are such that they would have been modifications that were *prima facie* obvious to the skilled artisan. It is noted that the claimed invention is not required to be

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expressly suggested in its entirety by any one or all of the references cited under 35 U.S.C. 103(a). Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Applicant's remarks have been fully and carefully considered in their entirety, but fail to be persuasive.

For these reasons, and those already made of record at pages 2-6 of the previous Office Action dated October 10, 2007, of which such reasons are incorporated herein by reference, rejection of claims 8-18, 20-27 remain proper and is **maintained**.

Conclusion

No claims of the present application are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action. Accordingly, **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136 (a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zohreh Vakili whose telephone number is 571-272-3099. The examiner can normally be reached on 9am to 6:00pm Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner
Zohreh Vakili
Art Unit 1614

April 23, 2008

/Ardin Marschel/

Supervisory Patent Examiner, Art Unit 1614